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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,919	06/21/2001	Rodrigo Munoz	G03.011	6655

28062 7590 01/27/2005

BUCKLEY, MASCHOFF, TALWALKAR LLC  
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NEW CANAAN, CT 06840

EXAMINER
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FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/886,919

Applicant(s)

MUNOZ ET AL.

Examiner

Daniel S Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-14, 17-19, 21-23, 25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-14, 17-19, 21-23, 25 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Receipt of the amendment filed October 26, 2004 amending claims 18 and 21 is acknowledged. Claims 1, 4-14, 17-19, 21-23, 25 and 27 are pending in the application.

### ***Response to Arguments***

2. Applicant's arguments filed October 26, 2004 have been fully considered but they are not persuasive. Applicant has made minor amendments to the preamble to clarify the word "type". However, the amendment still falls within the scope of the previously cited prior art. Moreover, references, in determining obviousness are not read in isolation but for what they fairly teach in combination with prior art as a whole and thus patent assignee's reference-by-reference attack on prior art to demonstrate non-obviousness is not persuasive (photoelectric sensing system) Banner Engineering v. Tri-Tronics Co. Inc., 29 USPQ 1392 1389 (CAFC 1993 unpub) citing Merck, 231, USPQ 375 (CAFC 1986).

Furthermore, it is respectfully submitted that references are evaluated by what they suggest to one versed in the art, rather than their specific disclosure [see In re Bozek, 163 USPQ 545 (CCPA 1969)]. In this case the primary reference, Tom, discloses an approval decision based upon a return on investment, by perfecting a credit managers evaluation and decision process to control loss. The Examiner interprets minimizing loss to have an effect on the ROI. The secondary reference, Maggioncalda discloses a financial advisory system for making approval decision for a recommended set of financial products based upon calculations of the highest

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investment return via one or more decision variables. The third reference, Ching discloses a specific return evaluation where the rate of return is compared to the expected rate of return before a decision is made. The 35 USC § 103(a) rejection set forth in the January 08, 2004 Office Action set forth reasoning for the combinations of references and resolve the level of ordinary skill in the art. In response to applicant piecemeal analysis of the references, the examiner respectfully submits that one can not show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. Specifically, the applicant discusses a return on investment based upon expected loss data and making an approval decision by comparing a calculated ROI with an expected ROI. These limitation were discussed in combination with Maggioncalda and Ching (see col. 37, ll. 38-51) where the shortcomings of Tom and Maggioncalda were addressed in view of Ching. It was stated that it would have been obvious for an artisan to have substituted the calculation of Ching in the invention of Maggioncalda and Tom being an art recognized equivalent to assess risk rates of return. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art. Again, the test for obviousness under 35 USC 103(a) is what the combined teachings would have suggested to one of ordinary skill in the art. [in re Keller, 642 F.2d 413, 208 USPQ 871(CCPA 1981); In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971)].

***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF  
January 07, 2004

Daniel S Felten  
Examiner  
Art Unit 3624

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

